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WENDEROTH, LIND & PONACK L.L.P.  
2033 K. STREET, NW  
SUITE 800  
WASHINGTON DC 20006

In re Application of:	:	
YAMAMICHI, Masato, et al.	:	DECISION REGARDING
U.S. Application No.: 10/567,584	:	SUBMISSION UNDER
PCT No.: PCT/JP2004/012226	:	37 CFR 1.42
International Filing Date: 19 August 2004	:	
Priority Date: 20 August 2003	:	
Attorney's Docket No.: 20006-0112A	:	
For: CONTENT REPRODUCTION	:	
SYSTEM	:	

This communication is issued in response to applicants' submission on 08 February 2006 of a declaration executed on behalf of deceased inventor Masato YAMAMICHI by the deceased inventor's heirs. The submission has been treated as a submission under 37 CFR 1.42.

### **BACKGROUND**

On 19 August 2004, applicants filed international application PCT/JP2004/012226. The international application claimed a priority date of 20 August 2003, and it designated the United States. On 03 March 2005, International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 20 February 2006.

On 08 February 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and the declaration considered herein under 37 CFR 1.42 and 1.497.

### **DISCUSSION**

37 CFR 1.42 states in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the MPEP states that the application can also be executed by all of the heirs of the deceased inventor, where no legal representative has been appointed or is required to be appointed by law.

37 CFR 1.497(b)(2) states:

If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to 37 CFR 1.497(b)(2), the citizenship for **both** the deceased inventor and the legal representative (or heirs) must be identified on the declaration (as well as the mailing address and residence information of the legal representative and all other information required under 37 CFR 1.497).

Here, the declaration filed 08 February 2006 includes the required citizenship, residence, and mailing address information for the persons signing the declaration on behalf of the deceased inventor. However, the declaration does not set forth the citizenship of the deceased inventor. In addition, neither the declaration nor any materials submitted therewith state that the three heirs listed in the declaration are the only heirs of the deceased inventor. Applicants must provide a revised declaration executed by the legal representative of the deceased inventor (or all his heirs) that includes all required information, including the citizenship of the deceased inventor. Such declaration must also make clear on its face, or be accompanied by a statement and/or supporting documentation confirming, that the persons executing the declaration on behalf of the deceased inventor are the only heirs of the deceased inventor.

### CONCLUSION

The declaration filed 08 February 2006 under 37 CFR 1.42 is **REJECTED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mail date this communication to submit a proper response under 37 CFR 1.42 and 1.497. Failure to file a proper and timely response will result in abandonment.

Extensions of time are available under 37 CFR 1.136(a).

A proper response must include a revised declaration executed by the legal representative of the deceased inventor (or all the heirs) that includes all the information required by 37 CFR 1.497 (including the citizenship of the deceased inventor), as well as a statement and/or supporting documentation confirming that the persons executing the declaration on behalf of the

deceased inventor are the only heirs of the deceased inventor. Applicants must also submit the \$130 surcharge for filing the declaration later than thirty months after the priority date.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'RM Ross', written in a cursive style.

Richard M. Ross  
Attorney Advisor  
Office of PCT Legal Administration  
Telephone: (571) 272-3296  
Facsimile: (571) 273-0459